

### **Remarks/Arguments**

#### **The Rejection of Claims 1-6, 8-12, 14-17, 19 and 20 Under 35 USC §102(b)**

In the Office Action of January 24, 2006 Examiner rejected Claims 1-6, 8-12, 14-17, 19 and 20 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. D459,744 (Apotheloz). Applicants respectfully traverse this rejection and request reconsideration.

Claims 1-8 have been cancelled and thus the rejection of those claims has been rendered moot. Claim 15 has been amended to be dependent on upon Claim 9 reciting the limitation of a removable panel. Claim 20 has been amended to recite that the microscope arm is curved and also recite that the interior and exterior surface of the microscope arm is curved. These elements are all missing from the microscope disclosed in the '744 patent.

#### **Claim 9:**

Claim 9 was rejected as anticipated by the '744 patent, but Applicants courteously submit that the rejection was improper because the curved microscope arm that is claimed in the original wording of Claim 9 is not found in Apotheloz. Claim 9 recites a fixed, arcuate recessed portion that exists on an arcuate microscope arm. Figures 1 (a reduced version of Figure 1 from the present application), 2 (a reduced version of Figure 1 from the '744 patent) and 3 (a reduced version of Figure 4 from the '744 patent) below starkly contrast the presence of a curved microscope arm in the present application, and the absence of that element in the '744 patent.

The Examiner points to Figures 1-12, in particular, Figures 1-4 in the '744 patent as substantiation that Apotheloz teaches a C-shaped microscope stand. The Examiner has indicated that a "first section", which supports the microscope, and a "second section", which connects the "first section" to the base, are the components that define the C-shape that anticipates the curved microscope arm. However, it is an unreasonable interpretation of the '744 patent to combine these two separate elements and equate them to be a single microscope arm. The "first section" is not part of the microscope arm, but is an objective mount that forms no part of the microscope arm. One of ordinary skill in the art would not equate the objective mount (the "first section") as part of the microscope arm, especially in this case, where it is evident that the objective mount is

a moving part. Microscope arms or stands are stationary elements on which elements of the microscope (such as objective mounts) are attached. The objective mount (the “first section”) is not part of the microscope arm.

The “second section” is indeed a microscope arm, but the drawings do not teach or suggest an arcuate microscope arm, but teach a straight microscope arm. While straight microscope arm has a curved V-shaped back, the microscope arm is not curved (see Figures 2 and 3 below). Consequently, all the elements of Claim 9, specifically an arcuate microscope arm, are not taught by the ‘744 patent.

Also not taught or suggested by Apotheloz is a **fixed** recessed portion, **which is arcuate**, on the interior surface of the microscope arm, as can be seen in Figure 3 below. The present application clearly discloses and recites in Claim 9 a **fixed** recessed portion that is **arcuate**. In Figure 1 below, the original Figure 1 from the present patent application has been reproduced in reduced size with descriptive labels added to highlight the important differences between the subject invention and the ‘744 patent and to emphasize the existence of a fixed, curved recessed portion and a curved microscope arm in the present application, and the absence of such in the ‘744 patent. These images demonstrate that independent Claim 9 of the present application is not anticipated by the ‘744 patent since this reference is missing two critical elements of Claim 9, namely, a recessed portion that is arcuate and a curved microscope arm.

Applicants respectfully disagree with the Examiner’s position that Apotheloz is an enabling reference which teaches the claimed subject matter of an fixed, arcuate recessed portion on the interior surface of the microscope arm. Apotheloz shows a microscope arm with an arcuate surface at the rear of the microscope arm, but the cavity on the inner surface is not completely shown. **It is impossible to determine from the drawings in Apotheloz, with any certainty, whether the cavity on the inner surface is arcuate, square, or some other shape entirely.** The Examiner has presumed that since the outer rear surface of the microscope arm has an arcuate surface, the cavity on the inner surface is arcuate as well. **Drawings and pictures can be used to anticipate claims if they clearly show the structure which is claimed** (See MPEP §2125; *In re Mraz*, 455 F.2d 1069). **Apotheloz does not clearly show an arcuate inner recess**

on the interior surface of the microscope arm. As Applicants understand the law on this point, there is a prohibition on drawings being used to teach or suggest claims if the drawing does not clearly show the structure which is claimed. Hence, Apotheloz is not an enabling reference that teaches an arcuate recessed portion on the interior surface of a microscope arm and a curved microscope arm. Consequently, the arcuate recessed portion recited in Claim 9 is not taught by Apotheloz and Claim 9 is not taught or suggested by Apotheloz.

Furthermore, Claim 9 also recites that the arcuate recessed portion is fixed. This feature is not taught or suggested by the '744 patent. Apotheloz discloses a stereomicroscope used for dissection where the specimen stage is also the base of the microscope. The specimen stage is not adjustable and remains at the base of the microscope. Because the specimen stage is immovable the only other way that the objectives can be focused is by moving the objective mount (the Examiner has called this the "first section") up and down on the microscope arm (the Examiner has called this the "second section"). The two knobs on the sides of the microscope arm provide the means of moving the objective mount up and down on the microscope arm. In order for the objective mount to be free to move up and down on the microscope arm, a recess is needed to provide the objective mount the space to move up and down. The recess shown on the '744 patent between the objective mount and the specimen stage provides the necessary space for the objective mount to move up and down. This recess, which provides the space or channel for the objective mount to move, is also the recess that the Examiner equated to the fixed, arcuate recess recited in Claim 9. As the objective mount moves down the microscope arm the recess is reduced in size. On the other hand, as the objective mount moves up the microscope arm the recess is enlarged. Consequently, the recess size taught and suggested by the '744 patent is changeable, but is subject to change and is therefore never fixed. Every time the focus on the '744 patent is adjusted the objective mount is repositioned and the recess enlarges or shrinks based on where the objective must be positioned. The fact that the recess in the '744 patent can change in size is directly opposed to the language recited in Claim 9 requiring that the recess be fixed. The common definition of the term fixed is: 1) Firmly in position; stationary; 2) Determined; established; set; 3) Not subject to change or variation; constant. None of those

definitions capture the characteristics of recess depicted in the drawings of the '744 patent, therefore, all the elements of Claim 9 have not been taught or suggested by the '744 patent. For all the reasons above, Apotheloz does not teach or suggest all the elements of Claim 9. Therefore, Applicants respectfully submit that Claim 9 is novel and dependent Claims 10-19, which further add limitations to the allowable subject matter of Claim 9, are also novel.

**Claim 20:**

Claim 20 was rejected as being anticipated by Apotheloz. Claim 20 as amended recites “a *curved* microscope arm having an interior surface and a *curved exterior surface*; said *curved interior surface* comprising at least one fixed recessed portion, said at least one fixed recessed portion extending from said curved interior surface of said curved microscope arm to an *arcuate inner recess surface* of said curved microscope arm, said fixed recessed portion comprising a surface for gripping said microscope.” (emphasis added). The Examiner asserts that Apotheloz anticipates Claim 20, but it is impossible to determine from the invention shown in Figures 1-12 of Apotheloz if the recess on the interior surface of the arm in Apotheloz is arcuate given the drawings provided, which means that Apotheloz is not an enabling reference that teaches an arcuate inner recess. Additionally, the microscope arm taught by Apotheloz is not curved. See discussion *supra*. Moreover, the recess taught by Apotheloz is not fixed. See discussion *supra*.

Applicants submit that for all of the above reasons independent Claim 20 is novel, and dependent Claims 21-27, which add further limitations to the allowable subject matter to Claim 20, are also novel. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections Claims 20-27.

The Rejection of Claims 7, 13 and 18 Under 35 USC 103(a)

The Examiner rejected Claims 7, 13 and 18 under 35 USC §103(a) as being unpatentable over U.S. Patent No. D459,744 (Apotheloz) in view of Stevens. Applicants respectfully request reconsideration and traverse the rejection.

Claim 7 has been cancelled which renders the rejection of that claim moot.

The combination of Apotheloz with Stevens fails to establish a *prima facie* case of obviousness for the present invention. In accordance with *In re Vaeck*, the prior art references combined must teach or suggest all the claim limitations. Applicants have shown supra that the '744 patent does not teach or suggest all the limitations of Claim 9. Nor does Stevens cure the deficiencies of Apotheloz. Therefore, Claim 9 is patentable over Apotheloz and Stephens. Claims 13 and 18, directly or indirectly dependent from Claim 9, enjoy the same distinction over Apotheloz and Applicants request reconsideration and withdrawal of the rejections of Claims 13 and 18, and passage to allowance of those claims.

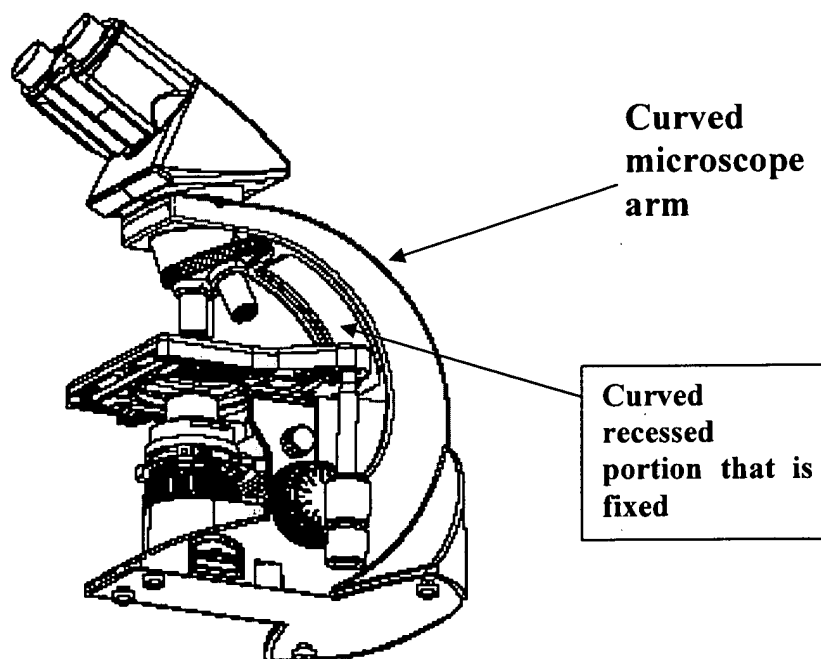


Fig. 1 – 10/811,348

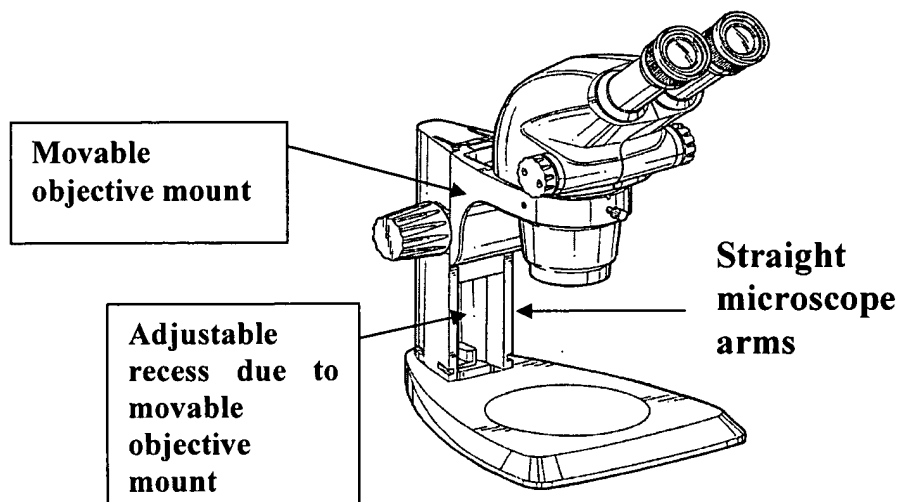


Fig. 2 - '744 Patent

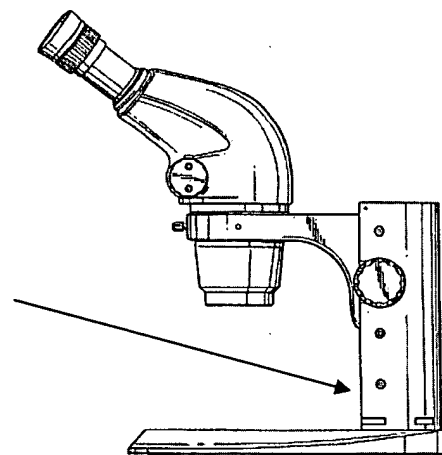


Fig. 3 - '744 Patent

### Conclusion

Applicants respectfully submit that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

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